

1. Claim Rejections

The Examiner has rejected claims 1-16, 19 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Takeo (6,075,877) in view of Hiyama (6,269,379). For at least the following reasons, Applicant traverses the rejection.

Claim 1 recites an image data handling method that comprises “adding combination information to the low-energy image data set and the high-energy image data set for indicating that the low-energy image data set belongs to the same combination as the high-energy image data set.” In the response to Applicant’s argument that links between files were not inherent to Takeo, the Examiner contends that, in his previous rejection, he was merely stating that there must be some way to identify images as low-energy, high-energy and subtraction images, not that these links are inherent to Takeo. The Examiner concedes that Takeo is silent on the concept of linking files by using combination data, but applies Hiyama to allegedly cure the deficiency. Office Action at page 5.

As best understood, partly based on the Examiner’s rejection of claim 13, the Examiner is contending that a group of high-energy, low-energy and subtraction data sets would have the same examination ID 71 as disclosed by Hiyama. The Examiner also contends that the region code 76 and the position code 77 as disclosed by Hiyama will identify each data set as a high-energy, low-energy or subtraction. Office Action at page 2. The Examiner contends that “this information is for medical images and that it would have been “obvious to change this information to correspond to the information needed for the method disclosed by Takeo.” Office Action of December 15, 2004, at page 3, which the Examiner incorporates in rejecting claim 1.

Hiyama relates to the problem of managing images acquired by an endoscope system or a diagnostic ultrasound system (col. 1, lines 14-15). To solve this problem, Hiyama discloses that management information consisting of “a region code [76] indicating a region to be examined in a human body, [and] a position code 77 indicating a detailed position of the region to be examined in a human body” is made part of the image file (col. 7, lines 9-11, Fig. 2). (emphasis added). Therefore, Hiyama clearly discloses that both fields 76 and 77 identify the part of the human body that is captured by the image (i.e., its own image file), not information related to combination data that relates the current image to other image files.

Hiyama, at most, discloses that a plurality of consecutive images may have the same examination identification number as part of the management information in the image file (col. 7, lines 1-5). Presumably, the examination identification is one of the parameters that an operator on conference unit 6 can input to retrieve desired image files (see Fig. 7 and related text). However, merely providing the same examination identification number to a group of image files does not provide information, within the current image file (i.e., image data set) that would relate the current image file to other image files (i.e., there is no information within the current image file that would indicate that other image files even exist, let alone that they belong to the current image file).

Therefore, Takeo in view of Hiyama does not disclose or suggest “adding combination information to the low-energy image data set and the high-energy image data set for indicating that the low-energy image data set belongs to the same combination as the high-energy image data set” as set forth in claim 1.

In addition, Applicant submits that management information, which identifies the portion of the human body captured in the image file, allows the system of Hiyama meet a primary objective of distinguishing between a plurality of reduced images (see col. 2, lines 26-29). Accordingly, it would not have been obvious to one skilled in the art to modify these fields to add combination data related to other images as suggested by the Examiner.

Therefore, the Examiner's contention that it would have been "obvious to change this information to correspond to the information needed for the method disclosed by Takeo" is not supported since it would require that the principle of operation with respect to Hiyama's management information would have to be modified (i.e., from information that identifies the part of a human body shown in its own image to information that identifies another image). The MPEP is clear in that, if a proposed modification changes the principle of operation of a reference, the teaching of the reference is insufficient to render the claims *prima facie* obvious. See MPEP at 2100-138.

Finally, Applicant submits that, as conceded by the Examiner, Takeo does not even provide the concept of adding combination data to the image data sets, and Hiyama, for at least the reasons given above, also does not render obvious the concept of providing combination data to image data sets. Therefore, the Examiner's explanation of how codes 76 and 77 can be modified to meet the claim limitations can only come from Applicant's specification, not from any disclosure in the prior art. Therefore, the Examiner has failed to make a *prima facie* case of obviousness for this additional reason since his proffered reason for combining the references is based on improper hindsight.

Because the Examiner's contentions in the rejection of claims 2-4 and 12 is similar to that given above for claim 1, Applicant submits that these claims are patentable for at least reasons similar to those given above with respect to claim 1.

Applicant submits that the remaining claims are patentable at least by virtue of their respective dependencies.

The Examiner has rejected claims 17 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Takeo in view of Hiyama and Cabrera *et al.* (US 6,029,160). For at least the following reason, Applicant traverses the rejection.

Because Cabrera does not cure the deficient teachings of Takeo in view of Hiyama given above with respect to claims 1 and 4, Applicant submits that claims 17 and 18 are patentable at least by virtue of their respective dependencies.

II. Conclusion

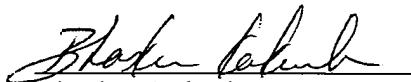
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

**Response under 37 C.F.R. § 1.116
U.S. Serial No. 10/014,506**

Attorney Docket No.: Q66577

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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